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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,942	08/04/2005	Ian D. Manger	20174-008610US	4959
20350 7590 03/16/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER HYUN, PAUL SANG HWA	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 03/16/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,942	<b>Applicant(s)</b> MANGER ET AL.	
	<b>Examiner</b> PAUL S. HYUN	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 14-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The Remarks filed by Applicant on November 17, 2009 has been acknowledged. Claims 1-34 are pending wherein claims 14-34 remain withdrawn pursuant to a restriction requirement. In summary, claims 1-13 are pending for examination on the merits.

The amended Abstract filed by Applicant has been acknowledged. Consequently, the objection to the Abstract cited in the previous Office action has been withdrawn.

Despite Applicant's argument with respect to the rejection, the rejection is maintained.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims **1-13** are rejected under 35 U.S.C. 102(e) as being anticipated by Van Dam et al. (US 2003/0008411 A1).

Van Dam et al. disclose a microfluidic device for synthesizing a library of compounds (see claim 15). The device comprises a solid substrate layer and an elastomeric layer attached to the solid substrate wherein the surface of the solid substrate is immobilized with ligands for binding analytes of interest. The surfaces of both layers can comprise grooves/wells to define a plurality of first flow channels intersecting a plurality of second flow channels such that the device comprises a plurality of inlets and outlets (see claim 24, [0048] and Fig. 12A). The device further comprises a plurality of control valves associated with each flow channel. The control

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valves are chambers/channels formed in the elastomeric layer. Upon application of an actuation force within the control valves (e.g. positive pressure), the elastic surface defining each control valve deflects into the flow channel and blocks fluid flow through the flow channel. The control valves can also be manipulated to function as a pump for facilitating the movement of fluids through the flow channels (see [0068] and [0069]).

The control valves formed at the terminus of the flow channels enable the formation of looped channels that redirect flow into an adjacent channel in a serpentine manner (see [0190]).

### ***Response to Arguments***

Applicant's argument with respect to claims 1-13 has been fully considered but it is not persuasive.

Applicant argues that the claims are patentable over the disclosure of Van Dam et al. because Van Dam et al. do not disclose the claimed "plurality of looped flow channels". Applicant's argument is based on the fact that Van Dam et al. do not disclose using its microfluidic device for looped flow applications. This argument is not persuasive because the distinction between the claimed invention and the device disclosed by Van Dam et al. pointed out by Applicant is based on the intended use of the two devices rather than a structural distinction. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance, the limitation "looped flow channels that each include

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segments of the flow channels between the intersecting volumes to define a closed loop” alone does not structurally distinguish the claimed invention from the channels disclosed by Van Dam et al. According to the claim language, the “looped flow channels” are merely segments of the flow channels between the flow channel intersections, which are present in the device disclosed by Van Dam et al. The limitations “looped flow channels” and “closed loop” merely indicate the path of a liquid flowing through the flow channels during the intended use of the claimed invention. The limitations do not confer additional structural features to the claimed invention. For the foregoing reason, the rejection is maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797